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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/479,549 01/07/00 ACKLEY, JR.

E 2280.2470 <sup>SM</sup>

EXAMINER

005514 IM22/0801  
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WEINSTEIN, S

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

08/01/01 <sup>9</sup>

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/479549

Applicant(s)

ACKLEY ET AL

Examiner

S. WEINSTEIN

Group Art Unit

1761

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 5/7/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-58 is/are pending in the application.
- Of the above claim(s) 5-8, 13-58 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 9-12 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 578
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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Applicants' traverse (filed May 7, 2001, paper No.7) to the restriction/election requirement (mailed April 6, 2001 paper No. 6) has been fully and carefully considered but is not found to be convincing. The restriction requirement details how the inventions are separate and distinct and is considered proper. In considering whether a restriction requirement was appropriate and did meet the criteria for restriction, the examiner did make the determination that examination of two or more groups would pose a burden on the Office. Also, a search of the apparatus is not mandatory in searching the method.

The restriction and election requirement is made Final. Claims 5-8 and 13-58 are withdrawn from further consideration as being drawn to non-elected inventions.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of the prior art in view of Yamamoto et al. ('252) and Redford et al. (WO91/01884) further in view of Ream et al. (WO97/16075) and Krubert ('273).

Applicants' admission of the prior art found on pages 1-12 of the specification discloses that it was known to print multicolor images on various products including food and that the multicolor images were made by two or more printing stations. Applicants' admission of the prior art also discloses that it was known in the art that it was important when providing two or more

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printing stations to insure that the object to be printed is in the same position at the second printing station as it was at the first printing station to achieve good images. Applicants disclose that the art uses the term "registration" for this concept. Claim 1 differs from applicants' admission of the prior art in that a pressure differential is maintained between the first and second printing station. Yamamoto et al. discloses a process for printing shaped edible pieces such as tablets or capsules. Yamamoto et al. transfers the edible product along in pockets wherein differential pressure is applied to the pockets to retain the edible product firmly in the pockets so that the edibles do not move during printing so that the printing is successful. Thus, Yamamoto et al. teaches the use of differential pressure to fix an article to be printed and to employ differential pressure to fix an article in a two step multi-color process which requires registration as the means to provide registration would have been obvious; especially in view of Redford et al. who teaches a two step imaging process on edibles and maintaining the edibles fixed in cavities by differential pressure during the two step process. Note that Redford et al. discloses that the transport can be along a conveyor and not just a wheel. Ream et al. and Krubert are relied on as further evidence of multicolor printing. In regard to claim 2, the particular material of construction of the recess is seen to have been an obvious matter of choice and/or design. Note too, the claims are method claims and not apparatus claims.

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Any inquiry concerning this communication should be directed to MK Weinstein at  
telephone number (703) 308-0650.

Weinstein/maj/lw

July 28, 2001

July 31, 2001

*Steven Weinstein*  
STEVEN WEINSTEIN  
PRIMARY ENGINEER  
ART UNIT 1761  
8/1/01